

Remarks

Claims 1-41 are presented for the Examiner's review and consideration. Claims 1, 8-9, 12, 14, 27, and 29 have been amended. Applicant believes the claim amendments and the accompanying remarks, herein, serve to clarify the present invention and are independent of patentability. No new matter has been added.

Interview

An Applicant Initiated Telephonic Interview with the Examiner was conducted on April 10, 2007. In accordance with MPEP §713.04, the substance of the interview was as follows:

- A) No exhibits were shown or demonstrations conducted.
- B) Claims 1, 12 and 27 were discussed.
- C) Prior art references Merchant (6,616,696) and Engh et al. (6,482,209) were discussed.
- D) It was agreed to amend claims 1, 12 and 27 with the word --only--, to specify only a single condylar compartment, thus overcoming Merchant. It was pointed out that an affidavit under 37 C.F.R. §1.131 would be submitted with respect to Engh et al.
- E) Arguments were substantially as described for item "D", above.
- F) No other pertinent matters were discussed with respect to this application. Other applications were discussed during the interview, the substance of which will be detailed in responses in the respective applications.
- G) Results were as described in "D", above.
- H) The interview was not conducted by email.

Priority

The Office Action states that Application No. 09/976,396 fails to provide adequate support or enablement for one or more claims of the invention. It further states that claims 1-41 are entitled to the benefit of prior application 10/191,751 filed July 8, 2002.

Applicant respectfully submits that it is entitled to a priority date as least as early as the file date of Application No. 09/941,185, or August 28, 2001. This application discloses the claimed subject matter of the present invention. Reference may be made, in particular, to Fig's. 40, 43-48, and 90-91 in the drawings, and paragraphs [0360]-[0372], [0393]-[0399], [0525]-[0528], and [0674]-[0680] in the specification. Accordingly, Applicant submits that the present application is entitled to an effective filing date at least as early as August 28, 2001.

35 U.S.C. §102(e) Rejection

Claims 1 and 6-7 were rejected under 35 U.S.C. §102(e) as being anticipated by Merchant (6,616,696) ("Merchant"). For reasons set forth below, Applicant respectfully submits that this rejection should be withdrawn.

The rejection further states that reference item 110 represents a first member affixable to one of a medial and lateral condyle of a femur portion of the knee joint. Applicant respectfully submits that item 110, described in Merchant as a femoral implant and shown in Fig. 3, clearly contains curved aspects representing both the medial and lateral condyles.

Item 122, shown in Fig. 3, is described as a bearing surface. (Col. 3, ln. 47-48). The tibial implant 114 also has a bearing surface 126 that slidably engages another portion of the femoral bearing surface 122 when the femur 104 and tibia 108 move relative to each other. (Id). As can be seen in the illustration, there are medial and lateral bearing surfaces, thus representing both condyles. Accordingly, item 110 cannot represent *one of a medial and lateral condyle*.

Merchant discloses a trochlear implant for use in a prosthetic knee. (Col. 2, lns. 25-26). The trochlear implant mounts to the knee end of a femur and cooperates with a patellar implant mounted to the back side of a patella. (Id). The patellar implant is a component of a prosthesis system including a femoral implant for replacing *the entire knee end of the femur* [emphasis added]. (Id). The trochlear implant has an articulation surface shaped to slidably receive a portion of the patellar implant. (Id).

The articulation surface 132 of the trochlear implant 130 is substantially similar in shape to a portion of the femoral bearing surface 122 of the femoral implant 110. Therefore, the patellar implant 112 is usable with both the femoral implant 110 and the trochlear implant 130.

When a patient's remaining joint surface deteriorates to the point where the trochlear implant needs to be replaced, in step 210 a femoral implant suitable for use with the trochlear implant is provided. (Col. 6, lns. 50-53). With reference to Fig's. 13-15 of Merchant, prosthetic knee systems usable with the invention are shown. (see Col. 6, lns. 24-40).

As such, Merchant discloses a patellar implant that is compatible with both a trochlear implant alone, or a femoral implant incorporating all of the lateral, medial, and trochlear portions of the femur.

Thus, Merchant does not show a prosthetic implant system comprising a first member affixable to *only one of* a medial and lateral condyle, a second member affixable to a trochlear section, and a third member affixable to an end portion of a tibia.

In contrast, in the present invention, a femur 126 is illustrated schematically in FIG. 56 and has a distal end portion 124 with a pair of condyles 890 and 892. (§[0525]) When a partial knee replacement is to be made, only one of the two condyles, that is the condyle 892, is cut. (Id).

FIG. 91 shows a bicompartiment arrangement that includes trochlear implant 1310 and medial implant 1312. (§[0675]). FIG. 92 shows the tibial component 1324, which articulates against medial section 1322. (Id). Implant 1316 can be made so that sections 1320 and 1322 are integral. (Id). Alternatively, implant 1316 could be modular, being assembled inside the body or outside of the body prior to implantation. (Id).

As such, the present invention discloses a prosthetic implant system comprising a first member affixable to *only one of* a medial and lateral condyle, a second member affixable to a trochlear section, and a third member affixable to an end portion of a tibia.

As noted above, Merchant discloses only a total replacement of the lower fibia, with a patellar implant compatible with same, or with the replacement of the trochlear groove alone. As stated in the present invention, replacement of the medial or lateral compartment through limited incision surgery and then patellofemoral replacement through the same incision or another incision will lead to faster patient rehabilitation. (§[0674]).

Claim 1 recites, *inter alia*, a prosthetic implant system for repairing a knee joint in a body of a patient, comprising: a first member including a first articulating surface, the first member affixable to only one of a medial and lateral condyle of a femur portion of the knee joint; a second member including a second articulating surface, the second member affixable to a trochlear section of the femur portion; and a third member including a third articulating surface, the third member affixable to an end portion of a tibia portion of the knee joint opposite the first member.

Accordingly, Applicant respectfully submits that claim 1 is patentable over Merchant. As claims 6-7 depend from Claim 1, these dependent claims necessarily include all the elements of the base claim. Accordingly, applicant respectfully submits that the dependent claims are allowable over Merchant for the same reasons.

In light of the foregoing, Applicant requests reconsideration and withdrawal of the section 102 rejections.

35 U.S.C. §103(a) Rejection

Claims 2-5, 11-13, 15-28, and 30-41 were rejected under 35 U.S.C. §103(a) as being unpatentable over Merchant in view of Engh et al. (6,482,209) (“Engh”). For reasons set forth below, Applicant respectfully submits that this rejection be withdrawn.

Applicant submits herewith an Affidavit of Prior Invention pursuant to 37 C.F.R. §1.131, which establishes by factual evidence that Applicant invented the subject matter of the present invention on or before the effective date of Engh.

Accordingly, Applicant respectfully requests that Engh be withdrawn as a reference with respect to the section 103(a) rejection.

As noted in the rejection, Merchant does not teach of a bone portion between the first and second members. Thus, absent Engh, the section 103(a) rejection should be withdrawn.

In light of the foregoing, Applicant requests reconsideration and withdrawal of the §103 rejection.

Allowable Subject Matter

Applicant notes with appreciation that claims 8-10, 14, and 29 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form, including all of the limitations of the base claim and any intervening claims.

Accordingly, claims 8-9, 14, and 29 have been correspondingly amended. Claim 10 depends from amended claim 9.

Accordingly, favorable consideration is requested.

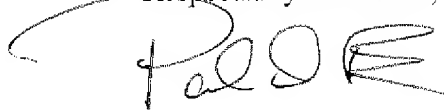
Applicant(s): P. Bonutti
Application No.: 10/727,290
Examiner: P. Philogene

Conclusion

In the light of the foregoing remarks, this application is now in condition for allowance and early passage of this case to issue is respectfully requested. If any questions remain regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

A fee of \$800 is believed to be due for four additional independent claims. However, please charge any required fee (or credit any overpayments of fees) to the Deposit Account of the undersigned, Account No. 503410 (Docket No. 780-A03-012D).

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Paul Bianco", with a large, sweeping flourish extending from the left side of the signature.

Paul Bianco, Reg. #43,500

Customer Number: 33771
FLEIT KAIN GIBBONS GUTMAN BONGINI & BIANCO, P.L.
21355 East Dixie Highway, Suite 115
Miami, Florida 33180
Tel: 305-830-2600; Fax: 305-830-2605